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Remarks

Reconsideration and allowance of the subject patent application are respectfully requested.

Claims 39-45 and 48-51 were rejected under 35 U.S.C. Section 101 as allegedly being directed to non-statutory subject matter. To advance prosecution, claims 39 and 48 have been amended to respectively refer to a messaging service client incorporated into a video game program "embodied on a storage device ...." and a server process "embodied on a storage device." In view of these amendments, claims 47 and 52 have been canceled without prejudice or disclaimer to eliminate potential redundancy. In addition, claim 46 has been amended for consistency with the amendment to claim 39. Based on these amendments, withdrawal of the Section 101 rejection is respectfully requested.

Claims 1-13, 16-31, 34-38 and 39-50 were rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over "First Internet Backgammon Server 1994 (FIBS)" in view of Instant Messaging Guide 1996 (IMG) in view of Tang *et al.* (U.S. Patent No. 5,960,173). While not acquiescing in this rejection, independent claims 1, 10, 28, 29, 39 and 48 have been amended. Conforming amendments have been to various dependent claims. As such, the applied references are discussed below with reference to the amended claims.

With respect to independent claims 1, 10, 28 and 29, a video game program for a video game is provided on a storage device (or medium) that is replaceably connectable to a video game system (or machine). The video game program includes program instructions both for the video game and for a messaging service client, whereby the messaging client is activated by connecting the storage device (or medium) to the video game system (or machine) and executing the video game program. This feature is described in the specification at, for example, page 20, lines 3 *et seq*. The activated messaging client establishes a connection between the video game system and a server. Among other things, because the video game program includes instructions both for a video game and for a messaging service client, access to a messaging service can be provided to video game players even if the though video game system does not have a multi-tasking environment in which different applications can be active at the same time.

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The documents applied against independent claims 1, 10, 28 and 29 in the office action do not render the subject matter of these claims obvious. Specifically, these documents, taken either alone or in combination, contain no disclosure or suggestion of, among other things, a video game program that includes program instructions both for a video game and for a messaging service client, or of executing a video game program to activate a messaging service client which then establishes a connection between a video game system (or machine) and a server.

The FIBS document contains no disclosure of a video game program embodied on a storage device that is replaceably connectable to a video game machine which connects to a server over the Internet as specified in independent claims 1, 10, 28 and 29. The FIBS document describes a backgammon game running on a FIBS server to which users connect, but there is no disclosure or suggestion of the program for this backgammon game being embodied on a storage device for a video game machine that connects to the FIBS server. That is, there is no disclosure or suggestion in the FIBS document of executing a video game program anywhere other than the server.

In addition, there is no disclosure in the FIBS document that the program for the backgammon game itself include program instructions both for the game and for a messaging service client, whereby the messaging service client can be activated by connecting the storage device to the video game system and executing the video game program embodied thereon as further specified in independent claims 1, 10, 28 and 29. As discussed above, this feature enables a messaging service client to be provided for a video game system even in a non-multi-tasking environment. This is not a problem in the computer-based environment of the FIBS system and thus there is no disclosure or suggestion that the program for the backgammon game also include program code for a messaging service client.

Moreover, there is no disclosure in the FIBS document of executing a game program to activate a messaging service client which then establishes a connection to a server. As noted above, in the FIBS document, the backgammon game is executed at the server and thus the activation of this game would not result in a connection to a server.

Further, the chat and player status features described in the FIBS document are limited to one game and thus there is no disclosure or suggestion in this document of

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players chatting with or seeing the status of players who are playing, for example, chess or an auto racing game. Thus, the FIBS document does not provide status data of one or more buddies on a buddy list if the user and one or more buddies are playing different games as further specified in independent claim 1, for example.

The IMG document does not remedy the deficiencies of the FIBS document. The IMG document describes instant messaging and various "popular" internet messaging clients. The instant messaging client described in the IMG document is a stand-alone client, and is not incorporated into a video game program or activated by executing a game program. There is also no disclosure of determining the gaming status of one of the buddies in a buddy list. Furthermore, the client is not described as being on a video game system or machine. Thus, even if the "buddy list" concept of the IMG document were somehow forcedly incorporated into the FIBS system, the subject matter of independent claims 1, 10, 28 and 29 would not have resulted.

Tang *et al.* is newly cited as allegedly providing "further evidence that monitoring users on different computer (sic) using different applications was well known in conjunction with providing user communication." Tang *et al.* discloses user interfaces and methods for improving user collaboration based on "task proximity." Workers are task proximate when they are working on the same or related data, with the same or related applications, at about the same time. While Tang *et al.* discloses identifying other workers that are in task proximity, there is no description of, among other things, a game program embodied on a replaceably connectable storage device that includes program instructions both for a video game and for a messaging service client, whereby the messaging service client is activated by connecting the storage device to the video game system and executing the video game program. As with the FIBS document and the IMG document, Tang *et al.* discloses a computer environment and thus there are no problems with different applications being active at the same time. Consequently, there is no disclosure or suggestion in Tang *et al.* that would have led one of ordinary skill in the art (absent the disclosure of the subject patent application) to incorporate program code for a messaging service client into a video game program. Thus, even were the teachings of Tang *et al.* somehow applied to the proposed FIBS-IMG combination, the subject matter of independent claims 1, 10, 28 and 29 would not result.

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   The dependent claims rejected based on the proposed combination of the FIBS document, the IMG document and Tang *et al.* are believed to be allowable because of their dependencies and because of the additional patentable features contained therein.

   Independent claim 39 is directed to a messaging service client incorporated into a video game program for a video game that is embodied on a storage device that is replaceably connectable to a video game machine for executing the video game program. The messaging service client is activated by executing the video game program. As discussed above, the applied references do not disclose or suggest incorporating a messaging service client into a video game program or activating the messaging service client by executing the video game program. Consequently, claim 39 and its dependent claims are believed to be allowable over the proposed combination of documents.

   Independent claim 48 is directed to a server process embodied on a storage device and comprising instructions executable by a server processing system for receiving identifiers of players and video games played by the players from a plurality of game machines which execute respective video game programs. The video game programs are each embodied on a replaceably connectable storage device and each comprise program instructions for both a video game and for a messaging service client, whereby the messaging client is activated by connecting the storage device to a corresponding game machine and executing the video game program. As explained above, the applied documents do not disclose or suggest the claimed video game programs or the claimed activating of the messaging service client. Consequently, claim 48 and its dependent claims are believed to be allowable over the proposed combination of documents.

   Claims 14, 15, 32 and 33 were rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over the proposed FIBS-IMG-Tang *et al.* combination in view of Best (U.S. Patent No. 5,393,073). Best is cited in the office action for its disclosure of a game console or hand-held gaming device and the office action purports that it would have been obvious to modify the proposed FIBS-IMG-Tang *et al.* combination to use either hand-held or console game machines. However, Best does not cure the deficiencies of FIBS-IMG-Tang *et al.* combination with respect to claim10 (from which claims 14 and 15 depend) or claim 29 (from which claims 32 and 33 depend). For at least these reasons, the proposed combination of the FIBS document, the IMG document,

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Tang *et al.* and Best would not have rendered the subject matter of claims 14, 15, 32 and 33 obvious.

    The pending claims are believed to be allowable and favorable office action is respectfully requested.

                          Respectfully submitted,

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